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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/571,604 | 03/15/2007 | Johan Theodoor Gerlich | B0285.0001/P001 | 9775 |
| 24998 7590 03/05/2009 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403 | | | | |
| EXAMINER | | | | |
| BARTOSIK, ANTHONY N | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3635 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/05/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/571,604

Applicant(s)

GERLICH ET AL.

Examiner

ANTHONY N. BARTOSIK

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) 6, 7, 14 and 15 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 8-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/26/2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This is a First Action on the merits sent in response to Applicant's submission of March 10, 2006.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the masonry or concrete wall must be shown as well as the plate being connected to each one of the pair of spaced apart elements, or the feature(s) canceled from the claim(s). It appears that the masonry wall is shown in Fig. 6. Since the specification does specifically disclose the concrete wall, and in order to keep the record clear, a drawing objection is made. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "23." Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) is required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cannarsa (U.S. 4,641,474).

5. In Re claim 1, Figures 1 and 4 of Cannarsa disclose a plate (10) for use in a sound attenuating building construction, said plate having first (12) and second (14) spaced apart flanges, said flanges extending inwardly from respective outer edges of said plate, and said flanges being substantially flat and lying in substantially the same plane, each flange being adapted for securement (28 & 32) in use to a respective element of said building construction, a resilient connection means (22, Col. 1, Lines 59-61) extending between adjacent inner edges of said flanges, said resilient connection means (22) consisting of a folded portion of the plate defining a single substantially "U" or "V" shape.

6. In Re claims 2 and 3, Figure 4 of Cannarsa discloses a respective upstanding locations means (54), those means being one or more projections.

7. In Re claim 4, Figure 4 of Cannarsa discloses a plurality of nail holes (the holes of 54).
8. In Re claim 5, Figure 1 of Cannarsa discloses the plate in the form on an elongated strip of intermediate length.
9. In Re claim 8, Figures 1, 3, and 4 of Cannarsa disclose a building frame including at least a pair of spaced apart frame elements (42 & 46) required to be connected together, at least one plate (10) having first (12) and second (14) spaced apart flanges, said flanges extending inwardly from respective outer edges of said plate (10), and said flanges being substantially flat and lying in substantially the same plane, each flange being secured to a respective said element, a resilient connection means (22) extending between adjacent inner edges of said flanges to space apart said elements, said resilient connection means (22, Col. 1, Lines 59-61) consisting of a folded portion of the plate defining a single substantially "U" or "V" shape, the arrangement being such that sound acting directly or indirectly on said elements will result in movement of said resilient connection means (22) to provide sound attenuation characteristics for a building construction in which said frame is incorporated.
10. In Re claims 11-12, Figures 1, 3, and 4 of Cannarsa disclose the claimed limitations.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 8 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Nanayakkara (U.S. 7,308,778).

13. In Re claim 8, Figure 3 of Nanayakkara discloses a building frame including at least a pair of spaced apart frame elements (28 & 30) required to be connected together, at least one plate (10) having first and second spaced apart flanges, said flanges extending inwardly from respective outer edges of said plate (10), and said flanges being substantially flat and lying in substantially the same plane, each flange being secured to a respective said element, a resilient connection means (22) extending

between adjacent inner edges of said flanges to space apart said elements, said resilient connection means (22) consisting of a folded portion of the plate defining a single substantially "U" or "V" shape, the arrangement being such that sound acting directly or indirectly on said elements will result in movement of said resilient connection means (22) to provide sound attenuation characteristics for a building construction in which said frame is incorporated.

14. In Re claim 13, Figure 3 of Nanayakkara discloses the elements (28 & 30) being a concrete wall.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrath et al. (U.S. 6,615,559) in view of Lundberg et al. (U.S. 3,950,912).

17. In Re claim 8, Figure 5 of McGrath et al. discloses a building frame including at least a pair of spaced apart frame elements (102b & 104b) required to be connected

together, at least one plate (106). McGrath et al. does not teach the particularly claimed structure.

Figure 1 of Lundberg et al. teaches a sound attenuating plate (1) having first and second spaced apart flanges (planer portions to the left and right of 3), said flanges extending inwardly from respective outer edges of said plate (1), and said flanges being substantially flat and lying in substantially the same plane, a resilient connection means (3 and 7) extending between adjacent inner edges of said flanges to space apart said elements, said resilient connection means (3 and 7) consisting of a folded portion of the plate defining a single substantially "U" or "V" shape, the arrangement being such that sound acting directly or indirectly on said elements will result in movement of said resilient connection means (3 and 7) to provide sound attenuation characteristics for a building construction (10) in which said frame is incorporated. It would have been obvious to one skilled in the art at the time of the invention to modify the plate of McGrath et al. to the shape of the plate in Lundberg et al. as a simple substitution of one known element for another to obtain predictable results.

18. In Re claims 9-12, the above combination teaches the claimed limitations.

19. In Re claim 13, the above combination teaches the claimed limitations except for the elements being a concrete wall. It would have been obvious to one skilled in the art at the time of the invention to construct the elements of McGrath et al. of cement to form

a concrete wall as a simple substitution of one known element for another to obtain predictable results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY N. BARTOSIK whose telephone number is (571)270-3112. The examiner can normally be reached on M-F 7:30-5:00; E.D.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

Anthony Bartosik
Examiner
Art Unit 3635
